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10/588,972	08/10/2006	Toshiyuki Fukushima	2006_1207A	4266
52349 7590 07/21/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
NGUYEN, HUY THANH				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/588,972

**Applicant(s)**

FUKUSHIMA ET AL.

**Examiner**

HUY T. NGUYEN

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 18 is/are rejected.
- 7) ☒ Claim(s) 12-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CS-100)
- Paper No(s)/Mail Date 6/08/09 9/15/06

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1 and 18 are objected to because of the following informalities: it is not clear on what part or parts in the claims "first area" and "second area" are located.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yap (6,711,486).

Yap discloses a recording and reproducing device (Figs. 1,5, column 3, lines 39-68, column 7, lines 30-49) that that records and reproduces information, said device comprising:

an obtainment unit operable to obtain first information;

an information recording unit operable to record the first information in a first recording area and to record second information in a second recording area, the first information being obtained by said obtainment unit, and the second information having the same

content as the first information;

an invalidation unit operable to invalidate the second information (user can not access the first information to be reproduced or transferred to the second area) ;

a receiving unit operable to receive a recording instruction which requests the first information recorded in the first recording area to be recorded in the second recording area (user makes payment and selects first information to be transferred to the second area);

a validation unit operable to validate the invalidated second information in the case where said receiving unit receives the recording instruction ( the first information is transferred and recorded on the second area (CD).

4. Claim 1 – 4 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Montoya et (5,949,688).

Regarding claims 1 and 18, Montoya discloses a recording and reproducing device (Figs. 3, column 3, lines 1- 58) that that records and reproduces information, said device comprising:

an obtainment unit operable to obtain first information;

an information recording unit operable to record the first information in a first recording area 220)and to record second information in a second recording area, the first information being obtained by said obtainment unit, and the second information having the same content as the first information;

an invalidation unit operable to invalidate the second information (user can not access

the first information to be reproduced or transferred to the second area) ;  
a receiving unit operable to receive a recording instruction which requests the first information recorded in the first recording area to be recorded in the second recording area (user makes payment and selects first information to be transferred to the second area, column 3, lines 20-26);  
a validation unit operable to validate the invalidated second information in the case where said receiving unit receives the recording instruction ( the first information is transferred and recorded on the second area (CD).

Regarding claim 2, Montoya further teaches the recording and reproducing device according to Claim 1, further comprising  
a management data recording unit operable to record, in a management data recording area, management data which is data indicating whether the second information is valid or invalid, wherein said invalidation unit is operable to invalidate the  
second information by making said management data recording unit record, in the management data recording area, management data indicating that the second information is invalid, and  
said validation unit is operable to validate the second information by making said management data recording unit update the management data so as to indicate that the second information is valid (Montoya teaches using r verified payment as management data for invalidating and validating the first information and second information on the first area and second area , column 3).

Regarding claim 3, Montoya further teaches the recording and reproducing device according to Claim 1, further comprising a judgment unit operable to judge whether or not there is a predetermined relationship between attribute information of the 5 first information obtained by said obtainment unit and attribute information (selected title information) of the information which is recorded in the second recording area, wherein said information recording unit is operable to record the second information in the second recording area in the case where said judgment unit judges that there is the predetermined relationship between the attribute information of the first information and the attribute information of the information which is recorded in the second recording area title information selected (the selected title of the first information is recorded on the second area as the second information) (column 3) .

Regarding claim 4, Montoya teaches a second information generation unit operable to generate the second information by converting a format of the first information to a format other than the format of the first information (CD format), wherein said information recording unit is operable to record the second information in the second recording area, the second information being generated by said second information generation unit (column 3).

Regarding claim 8, Montoya teaches a second recording area confirmation unit operable to confirm whether or not the second information is recorded in the second recording area, wherein said second recording area confirmation unit is operable to make said validation unit validate the second information in the case of confirming that the second information is recorded in the second recording area (column 3, lines 25 -35, column 4, lines 12 -27).

Regarding claim 11, Montoya teaches a reproduction disabling unit operable to disable reproduction of the first information in the case where said receiving unit receives the recording instruction (column 3, lines 20-25).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 5-7 and 9 -10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montoya et al in view of Nitta (5,381,275).

Regarding claims 5-7 and 9-10 Montoya fails to teach means for detecting the space available for recording the second information .

Nitta teaches a recording apparatus for recording information on a area having a control means for detecting the remaining capacity of the area and for controlling the bit rate of the information to be recorded on the area (Figs. 2-3, columns 4 -6).

It would have been obvious to one of ordinary skill in the art to modify Montoya with Nitta by providing the apparatus of Montoya with a control means as taught by Nitta for detecting the space on the second area and for controlling the recording of the second information on the second area thereby enhancing the capacity of the apparatus of Montoya .

#### ***Allowable Subject Matter***

7. Claims 12—17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571)272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Q. Tran can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HUY T NGUYEN/  
Primary Examiner, Art Unit 2621